

REMARKS

Applicants note that this application was remanded to the Examiner after an Appeal to the Board of Patent Appeals and Interferences. In the decision on that appeal, the Board reversed all of the Examiner's rejections under 35 U.S.C. §102. The Examiner issued a Final Office Action on April 29, 2003, whereby the rejections were switched from §102 to §103.

In the Final Office Action, Claims 1-6 and 8-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,581,615 ("*Cherukuri I*"), or U.S. Patent No. 4,794,003 ("*Cherukuri II*"), or U.S. Patent No. 4,452,820 ("*D'Amelia*"). Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over either *Cherukuri* or *D'Amelia* and in further view of U.S. Patent No. 4,246,286 ("*Klose*"). Applicants submit that all of these rejections are improper for reasons discussed below.

The present invention provides an "environmentally friendly" chewing gum composition that produces gum cuds having reduced adhesion compared to typical chewing gum compositions. To this end, it has been found that by reducing or eliminating inert filler from gum base and adding to the base or chewing gum formulation high levels of lecithin, it is possible to produce a chewing gum wherein the resultant gum cud has improved removability from surfaces.

Cherukuri I primarily relates to a chewing gum base composition which includes an elastomer, elastomer solvent, polyvinyl acetate, emulsifier, low molecular weight polyethylene, waxes, plasticizers and fillers. See Abstract [emphasis added]. As pointed out in Applicant's Reply Brief before the Board, the Patent Office's reliance on Table III, Run D is misplaced. Although the Examiner is correct in noting that no filler is disclosed in this example, no lecithin is disclosed either. Further, the Examiner fails to note that in the discussion with respect to Run D, the following is set forth:

The Run D results showed an increase in plasticizing that was so severe that the gum was extremely tacky and the gum could not be chewed. The gum exhibited disintegration.

See column 9, lines 44-47 [emphasis added].

As stated in the second heading of MPEP §2121.02, “[a] reference does not contain an “enabling disclosure” if attempts at making the compound or composition were unsuccessful before the date of invention.” *In re Wiggins*, 488 F.2d 538 (CCPA 1971).*

It is axiomatic that the formulation of Run D -- **importantly the only one in the entire reference which has no filler** -- does not constitute an “enabling disclosure.” Therefore, the Examiner’s reliance on Table III, Run D to show a chewing gum composition without filler is clearly contrary to the law, not to mention the Patent Office’s own internal examination guidelines.

Equally unavailing is the Examiner’s citation to Cols. 5 and 6 of *Cherukuri I*. As detailed above, there is no “enabling disclosure” in *Cherukuri I* for a chewing gum composition which has no filler. Even accepting the Patent Office’s theory that lecithin could be chosen as the emulsifier, this does not address the fact that no working examples are provided in *Cherukuri I* which include the combination of lecithin along with the complete absence of filler. In this regard, there is no disclosure or suggestion anywhere in *Cherukuri I* of a functional chewing gum composition including Applicants’ claimed lecithin percentages in combination with the complete absence of filler.

Indeed, the fact that all of the “working” examples include filler necessarily teaches away from the present invention which requires that no filler be present in the chewing gum base. In ascertaining the appropriateness of a particular reference as the basis for a rejection under §103, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert denied*, 469 U.S. 851 (1984). In reading the disclosure concerning the example which contained no filler, one skilled in the art would conclude that such a composition simply could not be made. Accordingly, Applicants respectfully request that this rejection under 35 U.S.C. §103(a) be withdrawn.

* Along a similar vein is *Reading & Bates Constr. Co. v. Baker Energy Resources Corp.*, 748 F.2d 645 (Fed. Cir. 1984) (reference that lacks enabling disclosure is not anticipating, but “itself may qualify as a prior art reference under §103, **but only for what is disclosed in it**”)(emphasis added).

Cherukuri II similarly fails to disclose or suggest all of the features of the claimed invention. *Cherukuri II* discloses a bubble gum base composition containing a combination of two PVA polymeric materials, namely a low molecular weight component and a medium molecular weight component, along with an acetylated monoglyceride having a saponification value above about 400. See Abstract. The composition preferably includes fillers in an amount of up to 40%. See Col. 2, lines 56-57 and Col. 7, lines 30-39. The inclusion of fillers, not to mention in such a high amount, clearly teaches away from the present invention where no filler is a required feature of the invention.

Further, Examples I and II which do include lecithin are using amounts, 0.060 and 0.5, far below Applicants' claimed percentage of 3-15%. Further demonstrating the weakness in the Patent Office's reasoning is that both Examples I and II include 25.5% and 6% filler, respectively. There is no clear teaching or suggestion in *Cherukuri II* for one to include 3-15% lecithin and no filler. The Patent Office, relies upon Claim 19 which depends on Claim 1 to support its position that a chewing gum without filler is disclosed.* However, where is the suggestion or motivation to combine this teaching with Applicants' claimed lecithin percentage of 3-15%? Accordingly, Applicants respectfully submit that this rejection under 35 U.S.C. §103(a) has been overcome and request withdrawal of same.

D'Amelia similarly fails to disclose or suggest all of the features of the present invention. *D'Amelia* discloses a single phase formulated homogenous gum base which contains a plasticized elastomer and a plasticized resin without the necessity of ester gum. See Abstract and Claim 1. Much like the other references relied upon by the Patent Office, the gum base may optionally include fillers in an amount of 0-60% and may optionally include emulsifiers in an amount of 0-10%. See Col. 5, lines 38-40 and Col. 6, lines 16-20. However, there is no clear teaching or suggestion to have a chewing gum base which includes no filler in conjunction with lecithin in an amount 3-15% by weight. In order for an obviousness rejection to be proper the prior art references must teach or suggest all the claim limitations. See MPEP 2143.

* Applicants further note for the record that emulsifiers and fillers both appear in optional component (e) of Claim 1. The Patent Office appears to be willing to ignore this obvious inconsistency in its own position, i.e., that the reference teaches the inclusion of one optional element (the emulsifier) which renders obvious Applicants' invention, but does not have the optional element (the filler) which is fatal to its own reasoning.

The Patent Office states that it would have been "obvious to select lecithin as the emulsifier." See Final Office Action at 2. However, that statement fails to address the crucial issue. The use of lecithin and the non-use of a filler are not optional components of the claimed invention as in *D'Amelia*. More specifically, the present invention requires that the chewing gum include lecithin, but no filler. Contrary to the Patent Office's assertions there is no clear teaching or suggestion anywhere in *D'Amelia* which relates to such a composition. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claim 7 requires the chewing gum include a color and an antioxidant. Applicants respectfully submit that Claim 7 is not obvious over *Cherukuri I* or *II* or *D'Amelia* in further view of *Klose*. As previously discussed, *Cherukuri I* and *II* and *D'Amelia* each fail to teach or suggest a number of features of the claimed invention, particularly the simultaneous inclusion of lecithin and exclusion of filler. Further, *Klose* does not disclose or suggest a chewing gum composition which includes 3-15 lecithin and no filler. Therefore, *Klose* cannot remedy the deficiencies of these references.

Furthermore, the mere fact that the references can normally be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Here, the Patent Office has not pointed to any suggestion that it would be desirable to add the antioxidants and color disclosed in *Klose* to the chewing gums of any of the primary references other than the fact that gum compositions in general can include such components. This ignores the above stated requirement concerning combinations or modifications to the teachings of the prior art to produce the claimed invention. Accordingly, Applicants respectfully submit that this rejection has been overcome and request withdrawal of same.

For the foregoing reasons, Applicants respectfully request reconsideration of their patent application and earnestly solicit an early allowance of same.

Respectfully submitted,
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